REMARKS

The applicants respectfully request reconsideration in view of the amendment and the following remarks. Support for newly added claims 23 and 24 can be found in the specification at page 7, lines 33-37. Support for newly added claim 25 can be found in original claim 1 and in the examples. No additional fee is required for the extra claims.

Claims 6-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al. or Vanderzande et al. or Issaris et al. These references are on record on Form PTO-1449. The applicants respectfully traverse this rejection.

The instant invention relates to a process for the manufacture of certain polymers as defined in claim 6 by reacting the monomer of the formula II **with a base in the presence of an alcohol as a solvent**, wherein the alcohol is a secondary or tertiary alcohol. This particular selection leads to the benefits as described in the instant specification.

Stern discloses the use of NatBuO as a base but is silent to add a secondary or tertiary alcohol. Even if such an alcohol may be formed during the reaction taught by Stern, there is no teaching given to add such alcohol from the beginning of the reaction is required by the applicants' claimed process. Hence the alcohol being formed by Stern is not acting as solvent per se.

The instant invention differs from the reference cited that the applicants (Stern), because the applicants add the alcohol as a solvent and not in the form as a base. Claim 26 requires that the alcohol and base are separate components. In the applicants' view, none of the references cited disclose, teach or motivate a person skilled in the art to add such alcohol as defined by the

applicants' process. The Examiner is establishing a hindsight position to make the instant invention obvious.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the

prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Stern et al. or Vanderzande et al. or Issaris et al.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

A three month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09931-00016-US from which the undersigned is authorized to draw.

Respectfully submitted,

By _____

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